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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,747	01/29/2001	John N. Wood	620-123	8145

7590 07/16/2002  
Nixon & Vanderhye  
8th Floor  
1100 North Glebe Road  
Arlington, VA 22201-4714

EXAMINER

BASI, NIRMAL SINGH

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 07/16/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/701,747

Applicant(s)

Wood et al

Examiner

Nirmal S. Basi

Art Unit

1646



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1<sup>256</sup> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 29, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-45 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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### DETAILED ACTION

Amendment filed 4/29/02 (paper number 8) has been entered. In view of Applicants Amendment and arguments filed 4/29/02 the Restriction in the previous office action is withdraw. A new restriction follows:

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#### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted. The invention must be elected from among the following Groups:

10

Group I, claims 1-19, 21-27, 38-41, drawn to a nucleic acid encoding SPASIC protein of SEQ ID NO:2 and variants thereof, protein encoded by said nucleic acid, recombinant vector containing said nucleic acid, host cell containing said recombinant vector and oligonucleotides suitable for use as primers, method of identifying and/or cloning said nucleic acid.

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Group II, claims 20 and 42, drawn to method of producing a derivative by modifying the nucleic acid of SEQ ID NO:1.

X

Group III, claims 28-30 and 43, drawn to method of influencing the electrophysiological and/or pharmacological property of a cell by altering the expression of the nucleic acid of claim 5.

X

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Group IV, claim 31, drawn to drawn to method of influencing the electrophysiological and/or pharmacological property of a cell by altering the expression of the nucleic acid of claim 10.

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✕ Group V, claim 32, drawn to transgenic animal.

Group VI, claims 33-36, drawn to method of identifying a substance having ion-channel modulating activity using the protein of claims 1 or 2.

5 Group VII, claim 37, drawn to polypeptide comprising an antigen-binding site of an antibody capable of specifically binding the protein of claim 1 or 2.

Group VIII, claim 44, drawn to method of identifying a substance having ion-channel modulating activity using the cell of claim 24.

Group IX, claim 45, drawn to method of identifying a substance having ion-channel modulating activity using the transgenic organism of claim 32.

10 The inventions listed as Groups I - IX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding technical feature for the following reasons. Group I is drawn to a nucleic acid encoding SPASIC protein of SEQ ID NO:2 and variants thereof, protein encoded said nucleic acid, recombinant vector, host cell containing said recombinant vector and oligonucleotides suitable for use as primers, method of  
15 identifying and/or cloning said nucleic acid, which is the first appearing product, method of making and method of using. The special technical feature of Group I is protein of SEQ ID NO:2 encoded by the nucleic acid of SEQ ID NO:1.

The methods of each group are materially different process steps; the process steps are the technical features which distinguish each method from the others. The products of each group are  
20 materially different, structurally and functionally which distinguish each product from the others.

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Because the process steps and products do not share the same or a corresponding special technical feature, unity of invention is lacking. The claims are not so linked by a special technical feature within the meaning of PCT Rule 13.2 so as to form a single inventive concept.

Applicant is advised that the response to this requirement to be complete must include an  
5 election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b)  
10 and by the fee required under 37 CFR 1.17(h).

#### Advisory Information

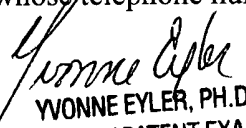
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirmal Basi whose telephone number is (703) 308-9435. The examiner can  
15 normally be reached on Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for this Group is (703) 308-0294.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal  
20 communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

25 Nirmal S. Basi  
Art Unit 1646  
July 15, 2002

  
YVONNE EYLER, PH.D  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600